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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,170	11/19/2003	Mirko Danz	DANZ-3	6001
20151 7590 05/01/2007 HENRY M FEIEREISEN, LLC 350 FIFTH AVENUE SUITE 4714 NEW YORK, NY 10118			EXAMINER BARNES, CRYSTAL J	
			ART UNIT 2121	PAPER NUMBER
			MAIL DATE 05/01/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/717,170	Applicant(s) DANZ ET AL.	
	Examiner Crystal J. Barnes	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7 August 2006</u> | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The following is an initial Office Action upon examination of the above-identified application on the merits. Claims 1-16 are pending in this application.

#### *Priority*

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### *Information Disclosure Statement*

3. The examiner has considered the information disclosure statement (IDS) submitted on 7 August 2006.

#### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims recite the broad recitation a control sequence, and the claims also recite in particular a motion sequence which is the narrower statement of the range/limitation.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The preamble states a project design method. However, no series of steps are claimed. For processes or methods, claim limitations define steps or acts to be performed. For products, claim limitations define discrete physical structures or materials. Product claims are claims directed to either systems, machines, manufactures or compositions of matter.

*Claim Rejections - 35 USC § 102*

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 5, 6, 8 and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 6,078,847 to Eidson et al.

As per claim 1, the Eidson et al. reference discloses a project design method for automating a control sequence, in particular a motion sequence, in a configurable system with a plurality of components, the components (see column 2 lines 24-29, "components") capable of exchanging at regular time intervals during the control sequence information (see column 2 lines 14-21, "material handling") with another of the components ("components") via communication relationships (see column 2 lines 24-29, "input paths 1-n, output paths 1-m"), wherein the system ("material handling system"), based on a topology (see column 2 lines 33-38, "topological map") and a functionality (see column 7 lines 34-38, "input functions, output functions") of the components ("components"), selects exactly one system project design (see column 4 lines 30-33, "appropriate components") from a plurality of system project designs ("basic components 22-30, 90, 95"), with the selected system project design ("appropriate components") containing exactly one component project design ("merge component 22") for each component ("components") of the system ("material handling system"), and designs each of the components ("components") in the system ("material handling system") according to the corresponding component project design ("merge component 22"); and wherein a particular component (see column 2 lines 39-42, "self-organizing elements 14")

implements the communication relationship ("input paths 1-n, output paths 1-m") to the other components ("components") according to the component project design ("merge component 22") of the particular component ("self-organizing elements 14").

As per claim 5, the Eidson et al. reference discloses the system ("material handling system") automatically determines the topology ("topological map") and functionality ("input functions, output functions") of the components ("components").

As per claim 6, the Eidson et al. reference discloses the system ("material handling system") automatically determines the topology ("topological map") of the components ("components") and aids a user in determining the system project design ("appropriate components").

As per claim 8, the Eidson et al. reference discloses the plurality of system project designs ("basic components 22-30, 90, 95") is centrally stored and the component project designs ("appropriate components") of the selected system project designs ("basic components 22-30, 90, 95") are transmitted to the components ("components").

As per claim 12, the Eidson et al. reference discloses the components ("components") activate the communication relationships ("input paths 1-n, output paths 1-m") established by the components ("components") based on a common activation command (see column 4 lines 33-36, "once connected").

As per claim 13, the Eidson et al. reference discloses the communication relationships ("input paths 1-n, output paths 1-m") conform to the IRTE protocol (see column 6 lines 18-21, "Ethernet ... protocol").

As per claim 14, the Eidson et al. reference discloses at least the topology (see column 8 lines 18-23, "topological map") of the components ("components") is made available to an application program (see column 8 lines 28-31, "monitoring computer system") for the configurable system ("updated system topology").

As per claim 15, the Eidson et al. reference discloses a configurable system for automating a control sequence, in particular a motion sequence, comprising: a plurality of components (see column 2 lines 24-29, "components") capable of exchanging at regular time intervals during the control sequence information (see column 2 lines 14-21, "material handling") with another of the components ("components") via communication relationships (see column 2 lines 24-29, "input paths 1-n, output paths 1-m"), means comprising a plurality of system project

designs ("basic components 22-30, 90, 95"), said means selecting exactly one system project design from the plurality of system project designs (see column 4 lines 30-33, "appropriate components"), with the selected system project design ("appropriate components") containing exactly one component project design ("merge component 22") for each component ("components") of the system ("material handling system"), wherein a particular component (see column 2 lines 39-42, "self-organizing elements 14") implements the communication relationship ("input paths 1-n, output paths 1-m") to the other components ("components") according to the component project design ("merge component 22") of the particular component ("self-organizing elements 14").

As per claim 16, the Eidson et al. reference discloses the components ("components") are at least partially implemented as exchangeable modules ("basic components 22-30, 90, 95").

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to process control systems in general:

USPN 7,050,808 B2 to Janusz et al.

USPN 6,957,186 B1 to Guheen et al.

USPN 6,882,347 B2 to Williams

USPN 6,877,033 B1 to Garrett et al.

USPN 6,871,299 B2 to Havekost et al.

USPN 6,810,401 B1 to Thompson et al.

USPN 6,344,855 B1 to Fisher et al.

USPN 6,131,119 to Fukui

US Pub. No. 2006/0020429 A1 to Brooks et al.

US Pub. No. 2005/0119959 A1 to Eder

US Pub. No. 2003/0172150 A1 to Kennedy


US Pub. No. 2002/0083076 A1 to Wucherer et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Crystal J. Barnes whose telephone number is

571.272.3679. The examiner can normally be reached on Monday-Friday alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 571.272.3687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
CRYSTAL J. BARNES  
PRIMARY PATENT EXAMINER  
CJB

20 April 2007